

42204

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Alison A. McCormick et al.

Serial No. 09/539,382

Filed: 31 March 2000

For: Self Antigen Vaccines for Treating B Cell Lymphomas
And Other Cancers

Art Unit: 1642

Examiner: Yaen

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REPLY TO OFFICE ACTIONAssistant Commissioner for Patents
Washington, D.C. 20231

Sir:

This Reply is responsive to the Office Action mailed 15 August 2002. The Examiner set a one-month period for response making the due date for response 15 September 2002.

REMARKS

In the Action, the Examiner adopted the position that the Preliminary Amendment filed 21 July 2002 is non-responsive.

Respectfully, Applicants believe to the contrary because a DIVISIONAL CPA was filed to introduce new claims for examination.

As noted in MPEP 201.06(d) in the section entitled, "Prior Election", (copy attached hereto) it is set forth that an election made in a prior application carries over to the CPA ONLY if ALL of the following are met:

- (1) ...the CPA is designated as a continuation...**(The instant CPA is a division.);**
- (3) ...the CPA presents claim(s) drawn to an invention claimed in the prior application **(The instant CPA contains newly presented claims not appearing in the parent application.);** and
- (4) the CPA does not contain an indication that a shift in election is desired. **(All of the original claims were canceled and new claims were presented in the CPA Preliminary Amendment.)**

Because three of the four criteria were not met, the election from the prior application cannot carry over to the instant CPA.

In MPEP 819, third full paragraph, (copy attached hereto) the MPEP teaches that a prior election carries over to a CPA, **THAT IS A CONTINUATION AND NOT A DIVISIONAL**, unless otherwise indicated by applicant.

The instant CPA is instead a division and there is clear indication new claims are to be examined.

Moreover, the MPEP provides two examples of defining the phrase, "otherwise indicated by applicant". (1) The CPA is filed as a division. (2) An Amendment filed prior to a first action in the CPA claims not previously elected.